

C. Remarks

The claims are 1-78, with claims 1, 11, 17, 44, 51-55 and 66 being independent. Claims 1-16, 24-37 and 51-55 have been withdrawn from consideration as being drawn to non-elected subject matter. Claims 17-23, 38-50 and 56-78 have been amended to correct minor informalities. Applicants submit that no new matter has been added. Reconsideration of the pending claims is respectfully requested.

Claims 17-23, 38-50 and 56-78 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, the Examiner suggested that the term “smoothly” in independent claims 17, 44 and 66 rendered the claims indefinite. Applicants respectfully traverse this rejection. At pages 6-7 of the originally filed specification, it is set forth: “If the wetting agent composition is a fluid, the fluid flows smoothly over the internal and external film surfaces and any matrices that may exist within the film, and forms a smooth surface with no beading.” One of ordinary skill in the art could readily appreciate the meaning of the term “smoothly” upon a reading of the above-noted disclosure of the application or upon reference to general accepted definitions for the term. For example, “smooth” can be defined as “even and uninterrupted in flow or flight” or as “free from lumps” (see <http://www.m-w.com/dictionary/smooth>). Applicants submit that the use of the term “smoothly” in each of the independent claims does not render the claims indefinite and that one of ordinary skill in the art would be apprised of the claim scope through ready appreciation of the meaning of the term “smoothly”. Accordingly, Applicants submit that the claims fully comply with §112, second paragraph, and respectfully request withdrawal of the § 112 rejection.

Claims 17-19, 21, 23, 38-44, 46-50, 58, 59, 76 and 77 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Drechsler (U.S. Patent No. 6,074,654) in view of Manufacturing Chemist, ExxonMobil Chemical Technical Data and Litton (U.S. Patent No. 5,970,989). Claims 17-19, 21, 22, 38-44, 46-50, 56, 57, 76 and 77 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Drechsler in view of Finkenauf (U.S. Patent No. 4,935,228), Amoco Technical Data and Litton. Claim 20 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Drechsler, Finkenauf, Amoco Technical Data and Litton, and further in view of Nichols (U.S. Patent No. 6,509,009). Claim 45 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Drechsler, Finkenauf, Amoco Technical Data, and Litton, and further in view of Chadfield (U.S. Patent No. 3,871,543). Claims 60-75 and 78 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Drechsler, Finkenauf, Amoco Technical Data and Litton, and further in view of STN-Registry. Applicants respectfully traverse these rejections.

At the outset, Applicants would like to incorporate by reference herein all previous arguments regarding the distinctions between the presently pending claims and the cited references, alone and in various combinations. What is more, Applicants would like to focus on the outstanding issues central to patentability of the present claims. More particularly, Applicants submit that the basic premise underlying the Examiner's obviousness case is flawed. The Examiner acknowledges that Drechsler fails to teach or suggest the use of a liquid polymeric hydrocarbon that has a number average molecular weight greater than about 650 in an overcoat composition. To remedy this deficiency, the Examiner cites to Manufacturing Chemist,

ExxonMobil or Finkenaure. However, these references fail to remedy the basic deficiency of Drechsler for differing reasons.

Manufacturing Chemist discloses that poly- α -olefins (notably polydecene) are popular as oil-free emollients, but contains no teaching or suggestion that emollients are useful in overcoat compositions to be used in combination with an anhydrous pigmented transfer resistant composition with which the poly- α -olefin is non-reactive but affinitive. Furthermore, Manufacturing Chemist contains no teaching or suggestion that an emollient would provide a lubricious feeling as required by Drechsler. Absent these teachings (or the teaching of such in some other reference), one of ordinary skill in this art would have no reasonable expectation of producing the presently claimed product with the desired features. In fact, given the vast number of potential cosmetic ingredients and the teachings of various advantages for each of those potential cosmetic ingredients, one of ordinary skill in the art would simply not have arrived at the claimed combination. It is only through an impermissible hindsight analysis that the Examiner accomplishes this.

ExxonMobil was cited for disclosing non-greasy poly- α -olefins having a specific molecular weight and their suitability for inclusion in cosmetics. However, not unlike Manufacturing Chemist, ExxonMobil contains no teaching or suggestion that such poly- α -olefins are useful in overcoat compositions to be used in combination with an anhydrous pigmented transfer resistant composition with which the poly- α -olefin is non-reactive but affinitive. ExxonMobil also contains no teaching or suggestion that poly- α -olefins would provide a lubricious feeling as required by Drechsler. Absent these teachings (or the teaching of such in

some other reference), one of ordinary skill in this art would have no reasonable expectation of producing the presently claimed product with the desired features. In fact, given the vast number of potential cosmetic ingredients and the teachings of various advantages for each of those potential cosmetic ingredients, one of ordinary skill in the art would simply not have arrived at the claimed combination. It is only through an impermissible hindsight analysis that the Examiner accomplishes this.

In sum, Applicants submit that the noted (by the Examiner) deficiency in the disclosure of Drechsler is not remedied by the Examiner's picking and choosing of features from secondary references, coupled with the citation of advantages of the features, for certain of a multitude of potential cosmetic ingredients. Such is no substitution for a motivation to combine the references.

The Examiner also cited to Finkenaar to remedy the deficiency of Drechsler. However, the unacceptability of such a combination was clearly demonstrated in the Declaration Under 37 C.F.R. 1.132 submitted with the previous response. The Examiner dismisses the declaration by stating that the obviousness rejection was "made on the premises that a skilled artisan would have added polybutene to the overcoating composition of Drechsler, rather than applying the whole mineral gel composition of Finkenaar". Again, here, the Examiner is picking and choosing features of a secondary reference in an attempt to arrive at the presently claimed combination of features. Again, here, the Examiner only arrives at such a combination through an impermissible hindsight analysis. There is simply no disclosure or suggestion in either Drechsler or Finkenaar which would motivate one of ordinary skill in the art to make the very

specific substitution noted by the Examiner. Absent such a teaching, one of ordinary skill in the art is faced with the multitude of potential cosmetic ingredients, each of which undoubtedly has shown advantageous features in some cosmetic composition, but would unlikely arrive at the presently claimed combination of features.

In conclusion, Applicants submit that the present invention is patentably defined by independent claims 17, 44 and 66 and that dependent claims 18-23, 38-43, 45-50, 56-65 and 67-78 are also patentable, in their own right, for defining other important features of the present invention, in addition to those recited in the independent claims. Simply put, none of the secondary references remedies the basic deficiency of Drechsler. Accordingly, Applicants respectfully request withdrawal of the §103 rejections.

In view of the foregoing remarks, favorable reconsideration and passage to issue is earnestly requested. Should the Examiner believe that issues remain outstanding, the Examiner is respectfully requested to contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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